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EXAMINER

NASH, LASHANYA RENEE

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2453

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/881,671	Applicant(s) CHERN, VINCENT	
	Examiner LASHANYA R. NASH	Art Unit 2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-18 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8,9,10, 12-18 and 27-35 is/are rejected.
- 7) ☐ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed 3 December 2009. Claims 1-4, 6, 8-18, 27-35 are presented for further consideration. Claims 5, 7, 19-26, are cancelled. No claims are currently amended.

Response to Arguments

In response to Applicant's argument (i.e. Jiang was filed on 16 August 2001, which is after the 18 June 2001 filing date of instant application) Examiner notes that Jiang claims priority to provisional application 60/261,572 filed 12 January 2001. The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph (See MPEP 2136.03). Examiner further asserts that provisional 60/261,572 clearly indicated support the subject matter relied on the rejections as set forth below in the Office action (pages 1-3; Figure 1).

In response to Applicant's arguments regarding claim 1, Applicant contends that Jiang et al. do not disclose or suggest that the stored state information allows the wireless communication device to return to the same state in the first server that existed prior to terminating the connection. Applicant further suggests that although Jiang teach

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that the CTI/IVR service "... allows a user to toggle between a between a voice session and a data session" that toggling between sessions does not disclose, expressly or inherently, that the wireless communications device is returning to the same state in the server. Examiner respectfully disagrees. Examiner asserts that in order to fully support the capability to toggle between a first voice connection and a data connection that a user device must return to a "same state", which the Examiner construes as an established connection. For example, according the teachings of Jiang, if an initial data session is established and subsequently a user device establishes as voice connection to the CTI/IVR that in order to accomplish toggling that the same state, or rather the initial connection with the data network must be performed. Further, Jiang et al. do not disclose or suggest that the connection with the first server is terminated through toggling. Applicant further contends that Jiang does not disclose terminating a connection with the session, as Jiang discloses that voice and data sessions are maintain concurrently. Examiner asserts that the term "terminating", in the broadest reasonable interpretation does not require that the device disconnect from a first server. Examiner asserts that a "termination of the connection" can be considered the end of a data session, as the user device transfers to connection to operate in a voice channel connection. Examiner suggests incorporating the limitations of claims 10 and 11, which explicitly recite that a step of "reconnecting" must occur with the first server, which implicitly suggests that a disconnection previously takes place, as opposed to a toggling of operation mode, as taught by Jiang.

In reference to claim 18, Examiner asserts as previously addressed in discussing arguments regarding claim 1 that Jiang discloses returning to a same state in order to fully support the capability to toggle between a first voice connection and a data connection. Furthermore, Examiner suggests incorporating the limitations similar to those of claims 10 and 11, which explicitly recite that a step of "reconnecting" must occur with the first server, which implicitly suggests that a disconnection previously takes place, as opposed to a toggling of operation mode, as taught by Jiang.

In reference to claim 34, Examiner asserts as previously addressed in discussing arguments regarding claim 1 that Jiang discloses returning to a same state in order to fully support the capability to toggle between a first voice connection and a data connection. Furthermore, Examiner suggests incorporating the limitations similar to those of claims 10 and 11, which explicitly recite that a step of "reconnecting" must occur with the first server, which implicitly suggests that a disconnection previously takes place, as opposed to a toggling of operation mode, as taught by Jiang.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4-6,8-10,12-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detlef (US Patent 6,351,523) in view of Jiang et al. (US Patent 7,092,370), hereinafter referred to as Detlef and Jiang respectively.

In reference to claims 1, Detlef discloses a method for providing voice responses to email messages (abstract). Detlef further discloses:

- A method for sending an audio file to an electronic email (email) recipient over a wireless communications network from a user of a wireless communication device (column 3, lines 50-63), the method comprising:
- Communicatively connecting to a first server (i.e. email server; Figure 1-item 36) over the wireless communications network (i.e. receive email; column 3, lines 50-59; column 4, lines 19-24);
- Receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient (i.e. user selects to generate voice reply message to email; column 5, lines 14-25);
- Establishing an audio connection between the wireless communication device and a second server (i.e. IFW; Figure 1-item 26) over the wireless communications network in response to the selected option, (i.e. voice reply to email; column 4, lines 23-40);

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- Recording the audio file on the second server (i.e. voice memo function recorded onto voicemail system column 3, line 67-column 4, line 6; column 4, line 62-column 5, line 7);
- Sending the recorded audio file to the email recipient as part of an email message (i.e. .wav file or other audio file, which is transmitted as an attachment to the email; column 5, lines 8-13; column 5, lines 20-25).

However, the reference fails to expressly disclose that the method comprises terminating the connection with the first server and establishing an audio connection between the wireless communication device and a second server; wherein the first server transmits a signal to the second server indicating a pending connection with the wireless communication device; the signal including information identifying the wireless communication device; and wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to a same state in the first server that existed prior to terminating the connection. Nonetheless, these were well known features in the art at the time of the invention as further evidenced by Jiang. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to accordingly modify the teachings of Detlef.

In an analogous art, Jiang discloses wireless voice and channel integration, where a voice session can be triggered from a data session (abstract). Jiang discloses terminating the connection with the first server and establishing an audio connection

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between the wireless communication device and a second server (i.e. wireless data session to trigger voice call to IVR; column 7, lines 53-60; column 10, lines 4-8); wherein the first server transmits a signal to the second server indicating a pending connection with the wireless communication device (i.e. concurrent voice channel and wireless data channels; column 7, lines 40-53); the signal including information identifying the wireless communication device (i.e. ANI data and UID data; column 7, lines 24-30); and wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the first server (column 7, lines 30-38) for allowing the wireless communication device to return to a same state in the first server that existed prior to terminating the connection (i.e. toggle between a voice session and data session), (column 5, lines 1-29; column 8, lines 9-25;). One of ordinary skill in the art would have been so motivated to accordingly modify the teachings of Detlef so as to remove problems of a tradition user navigating and controlling between a wireless channel to a voice channel during a communication session (Jiang; column 5, lines 10-21).

In reference to claims 18 and 27, Detlef discloses a method for providing voice responses to email messages (abstract). Detlef further discloses:

- A method for sending an audio file to an electronic email (email) recipient over a wireless communications network from a user of a wireless communication device (column 3, lines 50-63), the method comprising:

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- Connecting a wireless communication device to an email server (i.e. email server; Figure 1-item 36) over the wireless communications network (i.e. receive email; column 3, lines 50-59; column 4, lines 19-24);
- Receiving input from the user selecting an option presented by the email server to send a voice message to the email recipient (i.e. user selects to generate voice reply message to email; column 5, lines 14-25);
- Establishing an audio connection between the wireless communication device and a second server (i.e. IFW; Figure 1-item 26) over the wireless communications network in response to the selected option, (i.e. voice reply to email; column 4, lines 23-40);
- Recording the voice message on the second server (i.e. voice memo function recorded onto voicemail system column 3, line 67-column 4, line 6; column 4, line 62-column 5, line 7); and
- Sending the recorded voice message in an attachment to an email to the email recipient (i.e. .wav file or other audio file, which is transmitted as an attachment to the email; column 5, lines 8-13; column 5, lines 20-25).

However, the reference fails to expressly disclose that the method comprises connecting a wireless device to an email server by a data packet connection; terminating the connection with the email server and establishing an audio connection between the wireless communication device and an interactive voice response server; wherein the email server transmits a signal to the interactive voice response server indicating a pending connection with the wireless communication device; the signal

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including information identifying the wireless communication device; and wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to a same state in the email server that existed prior to terminating the connection. Nonetheless, these were well known features in the art at the time of the invention as further evidenced by Jiang. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to accordingly modify the teachings of Detlef.

In an analogous art, Jiang discloses wireless voice and channel integration, where a voice session can be triggered from a data session (abstract). Jiang discloses connecting a wireless device to an email server by a data packet connection (column 5, lines 1-29) ; terminating the connection with the email server and establishing an audio connection between the wireless communication device and an interactive voice response server (i.e. wireless data session to trigger voice call to IVR; column 7, lines 53-60; column 10, lines 4-8); wherein the email server transmits a signal to the interactive voice response server indicating a pending connection with the wireless communication device (i.e. concurrent voice channel and wireless data channels; column 7, lines 40-53); the signal including information identifying the wireless communication device (i.e. ANI data and UID data; column 7, lines 24-30); and wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the email server (column 7, lines 30-38) for allowing the wireless

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communication device to return to a same state in the first server that existed prior to terminating the connection (i.e. toggle between a voice session and data session), (column 5, lines 1-29; column 8, lines 9-25;). One of ordinary skill in the art would have been so motivated to accordingly modify the teachings of Detlef so as to remove problems of a tradition user navigating and controlling between a wireless channel to a voice channel during a communication session (Jiang; column 5, lines 10-21).

In reference to claim 35, Detlef discloses a system for providing voice responses to email messages (abstract). Detlef further discloses:

- A system (Figure 1), comprising:
- An electronic mail server, (Figure 1-item 36);
- A voice server (Figure 1-item 26) configured to generate audio filed in response to audio input (column 4, lines 19-40);
- A wireless communication device (Figure 1-item 12) including processor electronics configured to perform operations (column 3, line 64-column 4, line 21), comprising:
 - accessing an email message on the email server with the email server (column 3, lines 50-59; column 4, lines 19-23);
 - transmitting to the email server an indication to associate an audio file with the accessed email message (i.e. user selects voice reply to email; column 5, lines 14-25); and

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- communicating audio input corresponding to the audio file to the interactive voice response server (column 3, lines 50-59; column 4, lines 19-30).

However, the reference fails to expressly disclose that the method comprises connecting a wireless device to an email server by a data packet connection; terminating the connection with the email server and establishing an audio connection between the wireless communication device and an interactive voice response server; wherein the email server transmits a signal to the interactive voice response server indicating a pending connection with the wireless communication device; the signal including information identifying the wireless communication device; and wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to a same state in the email server that existed prior to terminating the connection. Nonetheless, these were well known features in the art at the time of the invention as further evidenced by Jiang. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to accordingly modify the teachings of Detlef.

In an analogous art, Jiang discloses wireless voice and channel integration, where a voice session can be triggered from a data session (abstract). Jiang discloses connecting a wireless device to an email server by a data packet connection (column 5, lines 1-29) ; terminating the connection with the email server and establishing an audio connection between the wireless communication device and an interactive voice response server (i.e. wireless data session to trigger voice call to IVR; column 7, lines

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53-60; column 10, lines 4-8); wherein the email server transmits a signal to the interactive voice response server indicating a pending connection with the wireless communication device (i.e. concurrent voice channel and wireless data channels; column 7, lines 40-53); the signal including information identifying the wireless communication device (i.e. ANI data and UID data; column 7, lines 24-30); and wherein the wireless communication device stores a set of state information, the state information comprising a status of an interaction between the wireless communication device and the email server (column 7, lines 30-38) for allowing the wireless communication device to return to a same state in the first server that existed prior to terminating the connection (i.e. toggle between a voice session and data session), (column 5, lines 1-29; column 8, lines 9-25;). One of ordinary skill in the art would have been so motivated to accordingly modify the teachings of Detlef so as to remove problems of a tradition user navigating and controlling between a wireless channel to a voice channel during a communication session (Jiang; column 5, lines 10-21).

In reference to claim 2, Jiang discloses dialing a phone number for connecting to the first server using the wireless communication device; and establishing a data packet connection between the wireless communication device and the first server (column 7, lines 5-30).

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In reference to claim 3, Detlef discloses wherein receiving input from the user selecting an option to send the audio file further comprises: receiving input from the user selecting an option to compose a new email message; and receiving input from the user selecting an option to attach the audio file to the new email message (column 3, lines 50-59).

In reference to claim 4, Detlef discloses the audio note taking method wherein the step of selecting an option to send the audio file further comprises: viewing a received email file on the wireless communication device, (Figure 2-item 60); selecting an option to respond to the received email file (column 4, lines 30-40), and selecting an option for attaching the audio file to the response to the received email file, (column 3, lines 50-59).

In reference to claim 6, Jiang discloses wherein the signal further includes user identification information (column 7, lines 24-30).

In reference to claim 8, Detlef discloses the audio note taking method wherein the step of recording the audio file further comprises: providing an audio input through the wireless communication device, ; and storing the audio input as an audio file on the second server (column 4, lines 13-35).

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In reference to claim 9, Detlef discloses the audio note taking method further comprises providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file, canceling the recording (column 5, lines 1-3).

In reference to claim 10, Detlef discloses the audio note taking method wherein the step of sending the audio file to the email recipient further comprises: transmitting a signal to the first server indicating that the audio file is ready to be sent; attaching the audio file to an electronic mail file; and sending the electronic mail file to the email recipient, (column 5, lines 14-25).

In reference to claim 12, Detlef discloses the audio note taking method wherein herein the reconnecting to the first server comprises providing the user with a plurality of options selected from the group consisting of: listening to a second audio file stored on the second server and reconnecting to the first server (column 5, lines 1-4).

In reference to claim 13, Detlef discloses the audio note taking method wherein the first server comprises an email server, (Figure 1-item 36).

In reference to claim 14, Jiang discloses the audio note taking method wherein the second server comprises an interactive voice response server, (column 7, lines 20-24).

In reference to claim 15, Jiang discloses the audio note taking mechanism wherein the first and second servers are connected by common platform means (column 6, lines 23-40).

In reference to claim 16, Detlef discloses the audio note taking method wherein the audio file comprises a .wav file, (column 5, lines 20-25).

In reference to claim 17, Detlef discloses the audio note taking method wherein the step of sending the audio file to the email recipient comprises the step of sending a hyperlink to the audio file stored on the second server (column 5, lines 13-25).

In reference to claim 28, Detlef discloses the audio note taking method wherein the email message comprises a new email message (column 3, lines 50-59).

In reference to claim 29, Detlef discloses the audio note taking method wherein the information uniquely identifying the wireless communication device comprises a telephone number corresponding to the wireless communication device (column 7, lines 24-30).

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In reference to claim 30, Detlef discloses the audio note taking method wherein the representation of the audio file comprises a link to the audio file stored on the voice server (column 5, lines 13-25).

In reference to claim 31, Jiang discloses the audio note taking method, wherein instructing the wireless communication device to connect to a voice server further comprises: transmitting to the wireless communication device a telephone number corresponding to the voice server (column 7, lines 53-60).

In reference to claim 32, Detlef discloses the audio note taking method wherein, wherein receiving input from the voice server indicating that the audio file is available further comprises: receiving information identifying the wireless communication device with which the audio file is associated (column 4, lines 30-40).

In reference to claim 33, Jiang discloses the audio note taking method, wherein the information identifying the wireless communication device with which the audio file is associated comprises a telephone number corresponding to the wireless communication device (column 9, lines 10-34).

In reference to claim 32, Detlef discloses the audio note taking method wherein, wherein the email server is further configured to receive the audio file from the interactive voice response server and transmit the audio file in association with the accessed email message (column 4, lines 30-45).

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Prior art has been cited that discloses a user device establishing concurrent voice channel and wireless data channels to a respective data server and voice server (i.e. IVR server), (i.e. Jiang). However, the prior art of record fails to disclose a method for sending an audio file to an email recipient, wherein a termination of a connection between a first server and a wireless communication device, in the form of a disconnection and reconnection to the aforementioned first server, is performed in order to record the audio file on a second server and subsequently sending the audio file to the email recipient.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LASHANYA R. NASH whose telephone number is (571)272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaShanya R Nash/
Examiner, Art Unit 2453
March 13, 2010

/Joseph Thomas/
Supervisory Patent Examiner, Art Unit 2453